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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,886	01/18/2000	Gale E. Smith	674506-2035.2	1236

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EXAMINER .

SRIVASTAVA, KAILASH C

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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SEP 30 2010

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

In re Application of: :
Smith et al. :
Serial No.: 09/484,886 : PETITION DECISION
Filed: January 18, 2000 :
Attorney Docket No.: 674506-2035.2 :

This is in response to the petition under 37 CFR § 1.181, filed September 17, 2010, requesting that the finality of the Office action of March 12, 2010 be withdrawn.

It is noted that applicants filed this petition under 37 CFR § 1.181 on September 17, 2010 requesting relief from the finality of the Office action mailed March 12, 2010. This petition was not filed within two months from the mailing of the final Office action and is thus untimely. Nevertheless, a decision on this petition is rendered herein.

BACKGROUND

The examiner mailed a non-final Office action on June 22, 2009 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 96-116 and 127-131 were pending. The examiner rejected claims 69-97, 99-116 and 130 under 35 USC 102 (b) as anticipated by Quelle et al. with evidence provided by Dorland's Illustrated Medical Dictionary.

In reply to the non-final Office action of June 22, 2009, applicants filed a response on December 16, 2009. The response submitted by applicants included remarks, arguments traversing the rejections made in the non-final Office action and cancellation of claims 1-131 and the introduction of new claims 132-152.

On March 12, 2010, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 132-152 were pending, and claims 132-152 were rejected. Claims 133-138 were rejected under 35 USC 112, first paragraph, as non-enabling. Claims 133-138 were rejected under 35 USC 112, first paragraph, as failing to

comply with the written description requirement. Claims 132-152 were rejected under 35 USC 112, second paragraph, as indefinite. The examiner rejected claims 132-138 and 151 under 35 USC 103 (a) as obvious over Quelle et al. in view of Dorland's Illustrated Medical Dictionary, and further in view of Inlow et al. Claims 139-150 were rejected under 35 USC 103 (a) as obvious over the combined teachings of Quelle et al. in view of Dorland's Illustrated Medical Dictionary, and further in view of Inlow et al. as applied to claims 132-138 and 151 and further in view of Morrison. Claims 152 was rejected under 35 USC 103 (a) as obvious over the combined teachings Quelle et al. in view of Dorland's Illustrated Medical Dictionary and Inlow et al. in view of Morrison as applied to claims 132-151 and further and additionally in view of Smith et al.

In response thereto, applicants filed this petition on September 17, 2010, requesting that the finality of the Office action of March 12, 2010 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed by applicants on September 17, 2010, applicants submit that the finality of the Office action of March 12, 2010 is premature. Applicants argue that "In the Office Action dated March 12, 2010, the Examiner rejected claims 132-152 under 35 U.S.C. § 112. Applicants respectfully submit that the new rejections were not necessitated by amendment of the previous response. In particular, the 35 U.S.C. § 112, first paragraph, rejection relates to EPO having an *in vitro* activity of at least 200,000 U/mg protein and 500,000 U/mg protein. Such a recitation was made in claims presented in an amendment filed March 25, 2009. Therefore, the new rejections were not necessitated by the amendment of the previous response as the recitation was present in the claims pending before the non-final office action. The recitations that are the subject of the rejections under 35 U.S.C. § 112 were in the claims pending before the issuance of a non-final office action. Therefore, Applicants are entitled to a first, non-final action on the merits to address these new rejections. Accordingly, based upon the aforementioned reasons, Applicant respectfully requests that the present Final Rejection be withdrawn."

Applicants' argument is well taken and persuasive since applicants' amendments did not necessitate the new rejection. It is pointed out that the language which forms the basis for the 35 USC 112, first paragraph, rejection was clearly present in the claims before the examiner at the time of the non-final Office action of June 22, 2009.

It is pointed out that MPEP § 706.07 recites:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37

CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

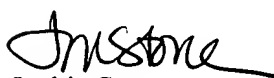
Thus, it is *not* proper for an office action to be made final when the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Accordingly, it is decided that Applicants' argument is well-taken and found persuasive.

DECISION

The petition is **GRANTED**.

The Office action mailed March 12, 2010 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action. The after final amendment of August 9, 2010 will also be entered. This application will be returned to the examiner for further action consistent with this decision and to act on the amendment of August 9, 2010.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Jackie Stone
Director, Technology Center 1600